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Kenichi Ohmae

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LEYDIG VOIT & MAYER, LTD  
700 THIRTEENTH ST. NW  
SUITE 300  
WASHINGTON, DC 20005-3960

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KENICHI OHMAE and YASUSHI ITO

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Appeal 2007-3104  
Application 09/623,575  
Technology Center 2600

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Decided: August 29, 2008

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Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO,  
and JOHN A. JEFFERY, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 29 and 31-69. We have jurisdiction under 35 U.S.C. § 6(b).

## SUMMARY OF DECISION

We reverse.

## INVENTION

Appellants' claimed invention pertains to an audiovisual authentication method and system for authenticating the actual viewing of education programs in remote education (Spec. 2:27-3:4).

Claim 29, reproduced below, is representative of the subject matter on appeal.

29. An audiovisual terminal comprising:

entry means through which a viewer of an audiovisual program enters a viewing confirmation code, for the audiovisual program, each time a viewing confirmation code is presented to the viewer, the viewing confirmation code to be entered being identical to the viewing confirmation code presented to confirm viewing of the audiovisual program, the viewing confirmation code entered being transmitted to a principal who authenticates viewing of the audiovisual program, the confirmation viewing code being presented by a program-providing principal at a time specific to the audiovisual program; and

transmitting means for transmitting to the principal, who authenticates viewing of the audiovisual program, the viewing confirmation code entered and

time information corresponding to the viewing confirmation code, for comparing the time information with the time specific to the audiovisual program.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

|            |                 |  |
|------------|-----------------|--|
| Von Kohorn | US 5,249,044    | Sep. 28, 1993                          |
| Vogel      | US 5,453,015    | Sep. 26, 1995                          |
| Lemelson   | US 5,823,788    | Oct. 20, 1998                          |
| Bates      | US 6,681,396 B1 | Jan. 20, 2004<br>(filed Feb. 11, 2000) |

The following rejections are before us for review.

1. Claims 29, 31-36 and 38-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lemelson in view of Vogel and further in view of Van Kohorn.
2. Claim 37 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lemelson in view of Vogel and further in view Von Kohorn and further in view of Bates.

### OBVIOUSNESS

The issue is whether the Examiner erred in rejecting claims 29 and 31-69 under 35 U.S.C. § 103(a). The issue turns on whether the Examiner's articulated reasoning for modifying Lemelson in view of Von Kohorn in the rejection possesses a rational underpinning to support the legal conclusion of obviousness.

## FINDINGS OF FACT

The relevant facts are:

1. Lemelson teaches that students respond to true/false, multiple choice or essay type questions posed by the instructor audibly or via a display (col. 1, ll. 48-56).
2. Lemelson further teaches that responses are transmitted to a base station with identifiers so that each response by a student is transmitted with an identifier code in order to link each answer with a student (col. 1, ll. 56-61).
3. Lemelson teaches that the base station displays the information to the instructor so that he/she can determine, during the lecture or course, how well the individual students are learning, and adjust the instructor's techniques based on the feedback (col. 2, ll. 8-12).
4. Von Kohorn teaches entering a viewed code identical to the displayed code in order to print coupons and prevent counterfeiting of such coupons (col. 5, l. 52-col. 6, l. 4 and col. 6, l. 23-col. 6, l. 45).
5. The Examiner's articulated rationale of modifying Lemelson with Von Kohorn is to safeguard against cheating (Ans. 5, and Examiner citing col. 5, l. 52-col. 6, l. 4; col. 6, ll. 23-45 and col. 6, ll. 23-45).

## PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR*

*Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellants to overcome the prima facie case with argument and/or evidence. (*See id.*)

The Examiner’s articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The Supreme Court, citing *In re Kahn*, 441 F.3d at 988, stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR, Int'l Co. v. Teleflex Inc.*, 127 S. Ct. at 1741. However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR*, 127 S. Ct. at 1740.

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983)

## ANALYSIS

*Did the Examiner err in modifying Lemelson with the teaching of entering a viewing confirmation code which is identical to the presented viewing confirmation code as taught by Von Kohorn?*

Appellants argue *inter alia* that:

[t]he Examiner analogized the question and answer feature of Lemelson to the viewing confirmation code feature of the claimed invention. However, there is no proper analogy. In Lemelson a substantive question is presented and a substantive answer is expected. Even if the answer to the question is selected from a group of proposed answers, i.e., is a multiple-choice question, or if the answer is simply a “yes” or “no”, the answer is clearly different from the question. If the presentation of the viewing confirmation code in the invention is considered to be a question, then the correct “answer” is the question, i.e., entry of an identical reproduction of the viewing confirmation code presented. Lemelson never discloses such an arrangement and cannot even suggest such an arrangement because it would be contrary to the intended and desired operation of the Lemelson system. If, in the Lemelson system, all of the answers received were identical to the questions, the lecturer in Lemelson

could gather no information as to how well the material being presented was being comprehended and could not determine whether to make some adjustment in the presentation of that material. In other words, Lemelson teaches away from the claimed invention. (App. Br. 14-15).

The Examiner responds that:

[i]t is obvious that the answer from a group of proposed answers is different from the question; However, the student uses an input device, i.e., Lemelson Fig. 2, for inputting the selected answer from a group of proposed answers. The selected answer is sending back to the lecturer and the selected answer is identical to one answer of the group of proposed answers, i.e., is a multiple-choice answer. As such, Appellant clearly misconstrues Lemelson's reference and the Examiner asserts that Lemelson does NOT teach away from the claimed invention, as alleged by Appellant. . . . Lemelson suggests at least one aspect of Appellant's invention, i.e., providing a way of verifying of users/students attentiveness based on scoring number of correct answers/responses versus incorrect answers/response (Col. 5; lines 65-Col. 6, lines 36) in which the inputted students' answers/responds, i.e., selected answer, is sending back to the lecturer, as above discussion.

Thus, what is missing from Lemelson is a viewing code that is identical to the presenting viewing code where the viewing code is transmitted after the presentation of the viewing code. This missing limitation is cured by Von Kohorn (Col. 5, lines 52-Col. 6, lines 4, 23-45), as discussed from the previous Office action. (Ans. 37-38).

Lemelson teaches that students respond to true/false, multiple choice or essay type questions posed by the instructor audibly or via a display (Finding of Fact 1). Lemelson further teaches that responses are transmitted to a base station with identifiers, so that each response by a student is transmitted with an identifier code in order to link each answer with a student (Finding of Fact 2). Furthermore,



Lemelson teaches that the base station displays the information to the instructor so that he/she can determine, during the lecture or course, how well the individual students are learning, and adjust the instructor's techniques based on the feedback (Finding of Fact 3). Thus, it is clear that Lemelson's invention relies on the substance of the answers in order to provide useful feedback to the instructor as to how well the students are learning (Findings of Fact 1-3).

Von Kohorn teaches entering a viewed code identical to the displayed code in order to print coupons and prevent counterfeiting of such coupons (Finding of Fact 4). Modifying Lemelson so that the students respond with entering a viewing confirmation code which is identical to the presented viewing confirmation code (i.e., answering the posed question with the posed question itself) would render Lemelson unsatisfactory for its intended purpose of providing useful feedback to the instructor as to how well the students are learning. *In re Gordon*, 733 F.2d 900. Thus, we are persuaded by Appellants' argument that Lemelson teaches away from the Examiner's modification.

Furthermore, we note that a student's answer to a multiple choice question is not identical to the posed question which includes all the possible answers. Thus, we do not agree with the Examiner's interpretation (Ans. 37-38) of the term "identical."

Finally, we do not agree with the Examiner's articulated rationale of modifying Lemelson with Von Kohorn in order to safeguard against cheating (Finding of Fact 5). We agree with Appellants that the reference to the prevention of "cheating" is regarding counterfeiting, not attentiveness, and the combination of the references clearly do not teach sending back to the lecturer the identical code to

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the one received (App. Br. 16-17). Thus, the Examiner's articulated reasoning in the rejection does not possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d at 988 (Fed. Cir. 2006).

Further, we find that Vogel and Bates fail to cure the shortcomings of Lemelson and Von Kohorn. Therefore, we do not find it necessary to address the rest of Appellants' arguments given that we find Appellants' argument concerning the combination of Lemelson and Von Kohorn to be persuasive.

Thus, the Examiner erred in rejecting claims 29 and 31-69 because Lemelson teaches away from the Examiner's modification and the motivation to combine the references does not possess a rational underpinning to support the legal conclusion of obviousness (Findings of Fact 1-5).

#### CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 29 and 31-69 under 35 U.S.C. 103(a).

REVERSED

KIS

LEYDIG VOIT & MAYER, LTD  
700 THIRTEENTH ST. NW  
SUITE 300  
WASHINGTON DC 20005-3960